

REMARKS

The Office Action dated October 1, 2008 has been carefully considered. Claims 21, 23 and 44 have been amended. Claims 1, 5, 11-14, 16-23, 38-40, and 42-44 are in this application.

The previously presented claims were rejected under 35 U.S.C. § 103 as obvious in view of U.S. Patent No. 5,440,961 to Lucas, Jr. et al. in view of U.S. Patent No. 5,440,961 to Wankow with supporting evidence from one or more of U.S. Patent No. 5,524,515 to Boda, U.S. Patent No. 4,210,043 to Urion et al., U.S. Patent No. 5,036,740 to Tsai, U.S. Patent No. 5,398,576 to Chiu, U.S. Patent No. 4,6960,022 to Chuang, "Phthalate Ester Plasticizers-Why and How They are Used" and U.S. Patent No. 4,856,975 to Gearhart and U.S. Patent No. 3,277,760 to Keene et al. Applicants submit that the teachings of these references do not teach or suggest the invention defined by the amended claims.

As noted during a March 4, 2008 interview, the Examiner indicated willingness to consider hard evidence of secondary considerations including failure of others, commercial success and copying by others.

In the Office Action, the Examiner noted that the declaration submitted under 37 C.F.R §1.132 filed 7/18/2008 is insufficient to overcome the rejections of claims 1, 2, 8-10 and 12-19 based upon their prima facie obvious as set forth in the last Office action. Applicants respectfully disagree.

With regard to point a, the Examiner indicated that the numbers presented were estimates and no methodology nor documentary evidence was submitted to support why the market moved from 100,000 conventional slide cutters to 30 to 50 million of slide cutter products. The number of slide cutter products sold is based on a report prepared by Presto, the parent corporation of Reynolds, in combination with the professional judgment of Paul Vegliante in estimating total sales in view of the known sales by AEP, Reynolds, Anchor, Metal Edge and Pliant, as noted in the report. The report will be submitted in a subsequent Declaration of Paul Vegilante.

The Examiner also indicated that no baseline market was established in 2000 since it only reflected AEP sales. However, applicants submit that only AEP was selling any variety of the slide cutter in the United States at that time because AEP had an exclusive license to sell the only slide cutter in production. Thus, contrary to the Examiner's assertion, applicants submit that a

base market of conventional slide cutters was established because the base line of sales is from the sales of AEP slide cutters.

The Examiner also asserted that applicants did not show evidence of what the Reynolds numbers were prior to selling copies of the AEP slide cutter. Applicants submit that until the time Reynolds started buying copies of the AEP slide cutter, Reynolds did not sell any slide cutters as AEP was the only entity selling slide cutters. Accordingly, with the advent of Reynolds selling copies of the AEP slide cutter, the sales of the Reynolds slide cutters went from zero sales to 12 million sales. As noted by the Declaration of Paul Vegliante, the slide cutter product corresponding to at least claim 1 of the present application has achieved commercial success with zero marketing dollars spent in marketing of the slide cutter product. AEP, the assignee of the slide cutter product, has sales of three million pieces per year based on the slide cutter product. An important feature highly appreciated by the customers and users is the functioning of the slide cutter product based on the cling of the plastic wrap to the cutter to enable the plastic wrap to be held in place before, after and during cutting of the plastic wrap.

With regard to point b, the Examiner indicated that there is no comparison of the pending claim to the accused infringer, applicants submit that the accused infringer's device is identical to applicants device and accordingly the infringing device would infringe the pending claims.

With regard to point c, the Examiner stated that there is no support that product (as in claim 1) and duplicates have penetrated only 25% of the market. Applicants submit that the other 75% of the market is related to conventional grater bar products of a serrated piece of metal affixed to the edge of the box. The only non-grater bar product on the market in 1992 was a slide cutter being manufactured in Taiwan for which AEP had the exclusive distributorship in the United States. Except for what AEP was selling, there was no one else selling a slide cutter in the United States. Thus, the base number for sales of slide cutters in the United States was whatever AEP sold. First sales were 25,000 in 1992 and increased to 100,000 in 2000. Moreover, this is the baseline number in the United States because no one else was selling a slide cutter in the United States. After AEP began selling slide cutters according to the present invention as claimed in at least claim 1, the sales by the AEP slide cutter alone rose to 3,000,000.

Applicants submit that the dramatic increase of sales from 1,000,000 to 3,000,000 of the slide cutters proves commercial success of the present invention.

With regard to point d, applicants note that the copies that are being sold in foreign countries are identical to the AEP product of the present invention as defined in at least claim 1. Applicants note that after a corresponding Canadian Patent issued on the present invention, Applicants successfully stopped a company, Metal Edge, from selling a duplicate product.

Chuang teaches a plastic film cutter slideable within a sliding furrow. On the bottom surface of the film cutter are rollers for keeping the film in a tensioned or flat shape.

In contrast to the invention defined by the present claims, Chuang does not teach or suggest that the rails are formed of a material of polyvinyl comprising at least 10% plasticizer, rubber or silicon elastimer and combinations thereof which provides an attraction to the plastic wrap received over the rails for attracting the plastic wrap received over the rails for clinging the plastic wrap to the rails before, during and after cutting of the plastic wrap by sliding the blade housing within the channel. Rather, Chuang teaches using roller means for keeping the plastic film in a tensioned state. The Examiner also indicated that the Chuang model is formed of rigid vinyl or PVC and that the rails are capable of attracting plastic wrap to the rails. Applicants respectfully disagree. As shown to the Examiner during an interview, Chuang does not provide any attraction of the plastic wrap to the rails, the plastic wrap is only held in a tensioned shape by the rollers of the Chuang film cutter. There is no teaching or suggestion in Chuang of the use of a material to provide attraction of plastic wrap to rails of a slide cutter device.

The Examiner also stated that Chuang does not disclose that the end surface of the upper housing is curved and that a designer could have decided to create a curve for its aesthetic appearance with no change to the function of the tool. Applicants respectfully disagree. As described on page 5, lines 1-12 of the present application, the shape of the end surface is defined to act in conjunction with the rails to allow the film to remain flat during sliding of the blade housing along the rails. Accordingly, there is a change in the function of the slide cutter of the present invention by use of the shape of the cutter. Furthermore, there is no teaching or suggestion in Chuang of the end surface of the cutter being rounded and inclined upwardly from either end and the advantages of this feature.

Lucas, Jr. et al. do not teach or suggest a film cutter apparatus including rails made from polyvinyl chloride with plasticizer. Wankow discloses a dispensing carton for a roll of sheet material including a clear vinyl spot of material attached to the dispensing carton to hold the film from falling back into the box. A cutter bar of a saw tooth metal strip is positioned proximate to the lower edge of the front wall. The sheet of material is brought into contact with the vinyl spots and torn by the cutter bar.

As noted by the Examiner neither Lucas, Jr. et al. nor Wankow teach the attractive material of the present invention of polyvinyl comprising at least 10% plasticizer, rubber or silicon elastimer and combinations thereof. Rather, Lucas, Jr. et al. is directed to an adhesive polyurethane tape and Wankow is directed to a clear vinyl spot. The Examiner indicated that "Phthalate Ester Plasticizers-Why and how they are used" (Phthalate") teaches the use of 40% plasticizer. The Examiner indicated that it would have been obvious to one of ordinary skill in the art to utilize a polyvinyl chloride with plasticizer material as the coating or tape. However, the invention defined by the present claims is directed to a rail and not a coating or tape and the rail is unrelated to the use of a plasticizer in a tape. Neither Lucas, Jr. et al. nor Wankow nor the "Phthalate" reference teach or suggest a rail formed of a material for providing attraction to plastic wrap received over the rails for clinging the plastic wrap to the rails before, during and after cutting by sliding a blade within a channel formed between the rails. The Examiner indicated that a person of ordinary skill in the art would recognize it would be advantageous to use the known property of vinyl attraction to retain the film in place during roll style cutting. However, there is no teaching or suggestion in Wankow of forming a rail from a material which provides attraction. In Lucas, Jr. et al., a non-slip surface formed of urethane tape is adhered a surface of the guide. However, similar to Wankow, there is no teaching or suggestion of forming a rail from a material which provides attraction. Furthermore, the "Phthalate" reference does not teach or suggest forming a rail from a first material which provides attraction to the film material for providing attraction to plastic wrap received over the rails for clinging the plastic wrap to the rails before, during and after cutting by sliding a blade within a channel formed between the rails.

In addition, none of the references teach the structure of a rail having cling properties to provide durability properties which is coextruded with a second material having rigidity. The present invention has the advantage that the rails continuously have the property of attraction to film before, during and after cutting of the film to the cutter apparatus during use and for the lifetime of the film cutter apparatus. The Supreme Court recently explained that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co., v. Teleflex, Inc.* ---U.S.---, ---, 127 S.Ct. 1727, 1741, 167 F.Ed.2d 705, --- (2007). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* Applicants submit that there is no reason that would have prompted one of ordinary skill in the art to combine the vinyl spots adhered to the side of a dispenser box of Wankow to adherence of the vinyl spots on a rail and even if the reference were combined the combination does not teach forming the rail itself formed by coextrusion, not simply adherence of a material to the rail, from a material to provide attraction to plastic wrap. In contrast, the urethane tape or vinyl spots adhered to a surface of a rail or dispenser box can lose this adherence and can be removed from the box during continuous use.

Gearhart teaches coextrusion of PVC to bond a capstock material in a relatively thin exposed superficial layer, to a substrate material which can be a PVC foam.

The capstock material is caused to flow in a manner which enables the capstock material to straddle the flow of substrate material so that the outlet of the flow passage for the capstock material has an arcuate kidney shape while the material flanked thereby has an acorn-shaped flow cross section and outer margins of the outlets for the two materials lie along a common circle upon which the inlet of the die is centered and with which the die inlet registers. Gearhart does not teach or suggest forming a rail by coextrusion in which the rail is formed of a first material to provide attraction to plastic wrap and a second material having rigidity.

Applicants submit that there is no reason that would have prompted one of ordinary skill in the art to combine the vinyl spots adhered to the side of a dispenser box of Wankow to adherence of the vinyl spots on a rail and in combination with a coextrusion method of Gearhart and even if the references were combined the combination does not teach forming the rail itself

by coextrusion, not simply adherence of a material to the rail, from a material to provide attraction of a plastic wrap to the rail before, after and during cutting of the plastic wrap.

Boda teaches a paper cutter assembly including a unitary base and rail arranged at right angles to each other. The rail assembly is in the form of a right angle extrusion. The angular construction provides a rigid structure throughout its length. However, Boda does not teach or suggest a coextrusion to form a rail material which provides an attraction to a plastic wrap and a base of a rigid material. Further, Boda does not teach or suggest coextrusion of a material of polyvinyl chloride having at least 10% plasticizer, rubber or silicon elastimer and combinations thereof and a material or rigid vinyl or PVC. The selection of the materials has the advantages of providing a material for a rail having cling properties and a material for a rail base having durability properties. There is no teaching or suggestion of these advantages in Boda. Accordingly, the invention defined by the present claims is not obvious in view of Lucas, Jr. et al. and Wankow in combination with Boda.

Urion teaches a cutting assembly by injection molding of side segments and upper wall segments at an angle relative to the position of the completed article. However, Urion does not teach or suggest a coextrusion to form a rail of a material which provides an attraction to a plastic wrap and a base of a rigid material. Rather, Urion is directed to injection molding which is unrelated to the coextrusion method of the present invention. Accordingly, the invention defined by the present claims is not obvious in view of Chuang, Lucas, Jr. et al. and Wankow in combination with Urion.

Tsai teaches a roller pressed film cutter apparatus. Four rollers are rotatably moving in a track. Film is pulled across the track and upon pushing of the slide holder the rollers will press and tension the film against the track. Stoppers 14 are opposed on opposite ends of the track.

In contrast to the invention defined by the present claims, Tsai does not teach or suggest rails being formed of a material providing an attraction to film received over the rails to cling the plastic wrap before, during and after cutting of the plastic wrap. In addition, Tsai does not teach or suggest end caps which release upon application of excessive force. Accordingly, Tsai does not cure the deficiencies of Lucas, Jr. et al. or Wankow noted above and the invention defined by

the present claims is not obvious in view of Lucas, Jr. et al. and Wankow in combination with Tsai.

Chiu discloses a cutting device for a roll of film including a cutter placed on a positioning unit. A guide unit includes two vertical plates projecting downwardly from the rear portion of the cutter through the slot and two horizontal plates that project outwardly from the lower edge of the vertical plates. The length of the vertical plates is slightly longer than the thickness of the top wall of the positioning unit so that the front portion of the sliding body can turn somewhat upwardly to facilitate cutting of the protective film by the cutting edge of the blade. The positioning unit further includes an upright front stop plate which is mounted securely on the front end portions of the side and top walls of the positioning unit, and an upright rear stop plate which is mounted removably on the rear end portions of the side and top walls of the positioning unit so as to permit removal of the cutter from the positioning unit.

In contrast to the invention defined by the present claims as noted above, Chiu does not teach or suggest rails being formed of a material providing an attraction to plastic wrap received over the rails to cling the plastic wrap to the rails before, during and after cutting of the plastic wrap. Further, Chiu does not teach or suggest that a blade is angled in a blade housing. Rather, Chiu uses the shape of the cutter to allow the sliding body to turn upward in order to prevent bunching of the film. Thus, Chiu does not cure the deficiencies of Chuang, Lucas, Jr. et al. and Wankow noted above. Accordingly, the invention defined by the present claims is not obvious in view of Lucas, Jr. et al. and Wankow in combination with Chiu.

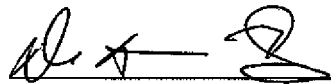
Keene et al. teach an apparatus for severing a web. The lower portion of a shuttle is an elongated cylindrical member which may be tapered at either terminal portion to engage insert 46. Means are used to hold the film adjacent to surface 14. (Col. 2, lines 34-37).

In contrast to the invention defined by the present claims, Keene et al. do not teach or suggest at least one rail being formed of a material providing cling properties to the plastic wrap received over the rail for attracting the plastic wrap to the rail, the material by rubber polyvinylchloride comprising at least 10% plasticizer, silicon elastimer and combination thereof. To the contrary, Keene et al. use means such as rollers to hold the plastic wrap down. Accordingly, Keene et al. do not cure the deficiencies of Lucas, Jr. et al.

In view of the foregoing, Applicants submit that all pending claims are in condition for allowance and request that all claims be allowed. The Examiner is invited to contact the undersigned should he believe that this would expedite prosecution of this application. It is believed that no fee is required. The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 13-2165.

Respectfully submitted,

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